

Appl. No. : 09/605,282  
Filed : June 28, 2000

Presentation Of Proposed Count

Claims 1-3 and 5-32 in the patent and the claims of the present application are identical. Accordingly, Applicant proposes that the count be all of the claims of the present application (i.e., Claims 6-36).

Identification Of Claims In Patent Corresponding To The Proposed Count

All claims in the Deutsch patent correspond to the proposed count.

Although Claim 4 of the patent is not identical to the proposed count, it merely sets forth an additional limitation that "the connector comprises a pressure coupling for connecting to the air valve stem." Since such pressure couplings are a well-known attachment mechanism, the additional limitation of claim 4 merely sets forth an obvious variation of the proposed count. As such, Claim 4 should be included among the claims corresponding to the count.

Presentation Of Claims Corresponding To The Proposed Count

All claims in the present application correspond to the proposed count.

Application Of The Terms Of The Application Claims Identified As Corresponding To The Count and Not Previously In The Application To The Disclosure Of The Application

Figures 1, 2, 8, and 9 and the accompanying description in the specification disclose the motion activated light recited in the apparatus claims, Claims 6-27. Page 4, paragraph 1 and page 6, paragraph 1 disclose the motion activated light for a vehicle wheel 4 having an air valve stem 41, as recited in Claim 6, the light having a connector 24 complementary to the air valve stem 41 for connecting the light thereto, a power source 14 connected to an electrical circuit 1, a light source L1-L5 connected to said power source 14 through the electrical circuit 1; and a switch 13 responsive to movement. Likewise, the device recited in Claims 7 and 8 is disclosed in page 6, paragraph 1 of the specification, with the air valve stem 41 and connector 24 having threaded ends 411. The power source 14 illustrated in Figure 1 discloses the battery recited in Claim 9, and the illuminators L1-L5 described in page 4, paragraph 1 disclose the light emitting diode recited in Claim 10. Additionally, the centrifugal force of Claim 11 is disclosed on page 4, lines 8-13.

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Likewise, Figures 1, 2, 8 and 9 and the accompanying description on page 4, paragraph 1 and page 6, paragraph 1 discloses the device recited in Claim 12. Specifically, Figure 8 shows an air valve 41 with a threaded stem 411 and a connector 24 with complementary threads for attaching the light to the stem. Figure 1 and page 4, paragraph 1 further discloses the power source 14 connected to an electrical circuit 1, lights L1-L5 connected to the electrical circuit and a switch 13 for closing the electrical circuit 1 in response to movement of the wheel 4. Figure 8 discloses the device illustrated in Claim 13. Additionally, page 5, paragraph 1 discloses the colored lights recited in Claim 14. The substantially waterproof enclosure of Claim 15 is disclosed on page 6, paragraph 1 and Figure 8 by the threaded nature of the motion activated light. Also, as described on page 5, paragraph 3 and page 6, paragraph 1, the housing 21 of the motion activated light is decorative or ornamental, as recited in Claim 16. Page 5, paragraph 1 describes lights emitting predetermined colors, as recited in Claim 17, and page 4, paragraph 1 and page 5, paragraph 2 disclose the motion sensitive switch 13 recited in Claims 18 and 19.

The device recited in Claims 20-27 is disclosed in Figures 1, 8 and 9 and the accompanying written description for those figures. Specifically, Figure 1 discloses the electric circuit 1 recited in Claim 20, and Figures 8-9 disclose the tire 4 and air valve 41 recited in Claims 20 and 21. Page 5, paragraph 3 and page 6, paragraph 1 discloses the ornamental shape of Claim 22, Figure 1 discloses the battery 14 of Claim 23, and page 4, paragraph 1 discloses the lights L1-L5 recited in Claim 24. Additionally, page 5, paragraph 1 describes the colored motion activated light of Claim 25, and page 4, paragraph 1 and page 5, paragraph 2 disclose the motion sensitive switch 13 recited in Claims 26 and 27.

The figures and written description cited above for the apparatus claims also necessarily disclose the methods recited in Claims 28-36 for using and implementing the light emitting apparatus. Figure 8, page 4, paragraph 1 and page 6, paragraph 2 disclose connecting a light source, or alerting circuit arrangement 1, to an air valve stem 41, the light activated by sufficient wheel motion and emitting light by causing the wheel to move, as recited in Claim 28. Page 6, paragraph 1 and Figure 8 further disclose the threaded air valve stem and complimentary threads on the motion activated light and connecting the valve stem to the light via a screwing motion, as recited in Claim 29. Page 6, paragraph 2 discloses driving a vehicle to move a wheel as recited in Claim 30. As previously noted, emitting lights of predetermined colors, as recited in Claim 31, is disclosed in page 5, paragraph 1.

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The method recited in Claim 32 is disclosed in Figures 8-9 and page 6, paragraphs 1-2. Figure 1 and page 4, paragraph 1 disclose the method of Claim 33. Figure 8 also discloses the inner tube having an air valve stem recited in Claim 34. The light emitting diode recited in Claim 35 is disclosed on page 4, paragraph 1, which identifies illuminators L1-L5, and page 5, paragraph 1 discloses emitting colored lights as recited in Claim 36.

Statement per 37 C.F.R. § 1.608(a)

Applicant's U.S. filing date is more than six (6) months before Deutsch et al. filed their application in the United States. Accordingly, Applicant alleges that there is a basis upon which the Applicant is entitled to a judgment relative to the patentee. Applicant believes that he was the first to conceive and reduce to practice the subject matter of the claims. Specifically, Applicant filed his priority application in Taiwan nearly fifteen (15) months before Deutsch et al. filed their first application in the United States. Moreover, Applicant has good reason to suspect that Deutsch et al. derived the claimed subject matter from Applicant.

RESPONSE TO OFFICE ACTION

Objection To The Drawings

The Examiner objected to the drawings for lack of labeling. Applicant has amended the drawings to provide labels, copies of which are included herewith, and respectfully requests that the Examiner withdraw the objection.

Rejection Of The Claims Under 35 U.S.C. § 112

The Examiner rejected Claim 4 under 35 U.S.C. § 112, noting that "the phrase 'such as', 'in other words' renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention." Applicant has canceled Claim 4 and the language objected to no longer appears in the claims. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of the claims under 35 U.S.C. § 112.

Rejection Of The Claims Under 35 U.S.C. § 103

The Examiner rejected Claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Szaniszlo (U.S. Pat. No. 5,803,574) in view of Gelormino et al. (U.S. Pat. No. 5,642,175).

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Additionally, the Examiner rejected Claim 5 as being unpatentable over Szaniszlo in view of Gelormino et al., and further in view of Trimble (U.S. Pat. No. 3,924,928). Applicant has canceled Claims 1-5 and replaced them with Claims 6-36.

These claims were copied directly from Claims 1-3 and 5-32 of U.S. Pat. No. 6,467,939 issued to Deutsch et al. In the Deutsch et al. patent, as set forth in the Examiner's Reasons for Allowance, the Office has determined that the "[p]rior art fails to show or suggest a motion activated light for a vehicle wheel having an air valve or a method associated therewith wherein the device comprises a connector complementary to the air valve stem, a power source, a light source and a switch as claimed wherein the switch is responsive to the movement of the wheel." The art cited in the rejection in the present application (i.e., the Szaniszlo, Gelormino and Trimble references) is of record in the Deutsch et al. patent. Moreover, the present application has both an earlier effective and actual filing date than the Deutsch et al. patent. Accordingly, in sole reliance on the Office's previous determination that the claims are patentable over the art cited in the outstanding rejection and all other art of record, Applicant respectfully submits that the identical claims in this application should also be allowed. Applicant further respectfully submits that the Office cannot reasonably and in equity allow the identical claims in the Deutsch et al. patent, and simultaneously reject those identical claims in this application. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of the Claims under 35 U.S.C. § 112.

#### CONCLUSION

Applicant has fulfilled all the requirements to provoke an interference. All of the rejections have been overcome. Applicant wishes to respectfully remind the Office of its obligation under 37 C.F.R. § 1.607 and M.P.E.P. § 2307 that "examination of an application in which applicant seeks an interference with a patent 'shall be conducted with special dispatch.'" In addition, Applicant has submitted a Petition to Make Special on the basis of infringement by another party. Accordingly, prompt examination at the art unit and at the Board of Patent Appeals is respectfully requested.

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Respectfully submitted,

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